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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| EXAMINER |
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SUHOL, DMITRY

| ART UNIT | PAPER NUMBER |
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3725

DATE MAILED: 09/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/808,456

Applicant(s)

MCADAMS ET AL.

Examiner

Dmitry Suhol

Art Unit

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1, 17 and 19 the limitation of "template-less" or "without a template" was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is simply no mention of the use of a template or lack thereof.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, it is not clear what feature is being claimed by the limitation of "including a guide". For examination purposes it is assumed that applicants are claimed an edge of the scanner/reader device.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 rejected under 35 U.S.C. 103(a) as being unpatentable over Lemelson et al '656 in view of Swartz et al '418, Gabritsos et al '250 and Nakazawa '288 or Ueno '750. Lemelson discloses a device for scanning and audio generation (as required by claims 18 and 20) from printed material containing most of the claimed elements, including with reference to claims 1, 17 and 19, a support medium including as least one page (book 2), printed matter including normal-sized printed text configured for a sighted person printed on at least one page (pictures and written text disclosed in col. 3, line 61), a bar code printed on the page (bar code 4), the bar code oriented parallel to an edge of at least one page and located within the margin of the page (figures 1 and 2 and col. 3, lines 59-61), the bar code emulating the printed text (col. 7, lines 37-41) and configured to be scanned by a hand held scanner (60). A contact type hand held scanner, as required by claims 1, 17 and 19, is shown as scanning device 60 in figure 4 whose function is described in col. 6, lines 32-41. The scanner being

provided with at least one guiding edge for guiding the scanner while scanning the bar code, as required by claim 2, is read onto the edge which guides the scanner along the edges 14 of cutout 12. The bar code being configured such that it is read top to bottom, as required by claim 3, is shown in figures 1 and 2. A right and left guiding edges, as required by claim 4, are read onto the right and left edge portions that contact the right and left edges 14 of member 8. The scanner including a wider upper body scanning portion (portion 62 where it is considered wide due to flange portion 39) provided with a left guiding edge and a right guiding edge (the right and left edge portions that contact the right and left edges 14 of member 80 and a thinner lower body gripping portion (gripping body 60 which is thinner than flange 39), as required by claim 5, is shown in figure 4. The medium being a book, as required by claim 6, is shown as book 2 in figures 1 and 2. The relationship of the bar code and printed matter as required by claims 8, 10, 18 and 20 is described in col. 7, lines 37-41. The relationship of the bar code and at least one picture, as required by claim 9, is shown in figures 1 and 2.

Gabritsos is relied upon to teach that it is known to manufacture a children's book with printed matter (figure 1) and related machine readable code (12) which is read by a device (16) having a guiding edge (18) cooperating with the edge (14) of the book so that the device travels along the machine readable code. Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention, to have manufactured the hand held device and book portion of Lemelson with a guide edges of Gabritsos instead of the template (8) since they carry out the same function and are therefore art recognized equivalents and the selection of any of these known

equivalents to guide a hand held reader along a page would have been within the level of ordinary skill in the art.

Lemelson fails to explicitly teach that his bar code is a Braille linear high density multidimensional type barcode (2-D as required by claim 15) as required by claims 1, 17 and 19. However, Swartz discloses a device which converts bar code data into audible sounds (used for blind people col. 4, lines 59-62) which teaches that it is known to use a variety of bar codes including a Braille type linear high density multidimensional type barcode (col. 4, lines 27+). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention to have utilized a Braille type linear high density multidimensional type barcode (including a 2-D bar code) since the use of a particular type bar code would only depend on the amount of information to be stored and conveyed, especially since Lemelson clearly states that he envisions for his device to be utilized by the handicapped (col. 1, lines 57-61). Furthermore, the specific bar code dimensionality is considered to be a design choice in that applicants disclose that the bar code used in their invention may be of any type desired (page 12, lines 12-14 and page 18, lines 6-8).

Nakazawa and Ueno are both relied upon to teach that it is known to manufacture a contact type scanning/reading device with an omni-directional photo emitter/receptor which is operable when in contact with a 2-D bar code. Therefore it would have been obvious to one utilize a construction with the scanner/reader of Lemelson being one such that a 2-D bar code may be read, especially since Lemelson clearly uses a contact type scanner/reader and makes no distinction of whether his bar

code is one dimensional or multidimensional and the use a 2-D bar code would have been obvious as it would only depend on the amount of information to be encoded (as stated above).

Regarding the positioning of the Braille type bar code, as required by claims 1-5, 7, 12-14, and the additional printed matter as required by claim 1. It would have been obvious to one having ordinary skill in the art at the time of the claimed invention to place the Braille type bar code in any location on the page since it would only depend on the intended use of the assembly and the desired information to be displayed and since Lemelson states that the bar code of his invention may be placed in rows or columns anywhere on the pages provided that it does not interfere with the printed text. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of placement for the Braille code does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. Braille bar code location or additional printed matter) and the substrate (support medium) which is required for patentability. Additionally the location of the placement of the Braille bar code is considered to be a design choice since applicants do not disclose any advantage or criticality for such placement and it would appear that the device would

work equally well no matter the positioning of the bar code (see applicants specification page 15, lines 15-20).

Regarding the dimensionality of the Braille bar code as required by claims 1, 11 and 15-17 and 19, it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention to have manufacture the bar codes of Bail as a two or three dimensional bar code for the purpose of holding varying amounts of information and since the examiner takes official notice that such bar code construction is well known in the art. Furthermore, the specific bar code dimensionality is considered to be a design choice in that applicants disclose that the bar code used in their invention may be of any type desired (page12, lines 12-14 and page 18, lines 6-8).

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz '418 in view of Lemelson '656 and Nakazawa '288. Swartz discloses a device in book form (figure 3) having printed matter including text for a sighted person (45), the device converting bar code data into audible sounds (used for blind people col. 4, lines 59-62) and teaching that it is known to use a variety of bar codes (42) including a Braille type linear high density multidimensional type barcode (col. 4, lines 27+).

Lemelson is relied upon to teach placement of a bar code in the margin portion of a book (figures 1 and 2 and col. 3, lines 59-61) within an environment like that of Swartz for the purpose of not interfering with the printed matter of the book. Therefore it would have been obvious to place the bar code of Swartz in a margin location or another location so as not to interfere with the printed matter of the pages.

Nakazawa is relied upon to teach the use of a contact type hand held scanner (see figure 8 for example) usable with a 2-D bar code (col. 7, lines 35-40) and having left and right guiding edges (read onto the edges of the scanner as broadly claimed) with a wider body scanning portion and a thinner lower body gripping portion (see figures 4A, 5A-6B and 7-9). Nakazawa further teaches the use of an omni-directional photo emitter/receptor with a contact type scanner/reader (figure 1 and 12). Therefore it would have been obvious to utilize the scanner/reader of Nakazawa in the system of Swartz for the purpose of scanning a wide bar code without having to increase the size and length of the scanner/reader device.

Regarding the positioning of the Braille type bar code, as required by claims 1-5, 7, 12-14, and the additional printed matter as required by claim 1. It would have been obvious to one having ordinary skill in the art at the time of the claimed invention to place the Braille type bar code in any location on the page since it would only depend on the intended use of the assembly and the desired information to be displayed and since the teachings of Lemelson states that the bar code of his invention may be placed in rows or columns anywhere on the pages provided that it does not interfere with the printed text. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of placement for the Braille code does not alter the functional relationship. Mere support by the substrate for the

printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. Braille bar code location or additional printed matter) and the substrate (support medium) which is required for patentability. Additionally the location of the placement of the Braille bar code is considered to be a design choice since applicants do not disclose any advantage or criticality for such placement and it would appear that the device would work equally well no matter the positioning of the bar code (see applicants specification page 15, lines 15-20).

Response to Arguments

Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 571-272-4430. The examiner can normally be reached on Mon - Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3725

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Dmitry Suhol
Primary Examiner
Art Unit 3725

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